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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,631	04/12/2004	Al Speyer	P04025US1A	1934
7590 01/23/2006 Bridgestone Americas Holding, Inc. 1200 Firestone Parkway Akron, OH 44317			EXAMINER FISCHER, JUSTIN R	
			ART UNIT 1733	PAPER NUMBER
DATE MAILED: 01/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/822,631

Applicant(s)

SPEYER ET AL.

Examiner

Justin R. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 8-11 and 18-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-17 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>081004, 092205</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, 12-17, and 23-26, drawn to a tire/tire kit, classified in class 152, subclass 450.
 - II. Claims 8-11 and 18-22, drawn to a method of changing a tire, classified in class 157, subclass 1.1.
2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the tire/tire kit can be used in a materially different method, for example one dealing with passenger car tires instead of racing vehicles (language of claim 1 is intended use). Additionally, the tire/tire kit having indicia does not have to be used in a tire changing method (can be used in mounting operation in which no tires are present- e.g. new car).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Timothy Krogh on January 18, 2006 a provisional election was made with traverse to prosecute the invention of a tire/tire kit claims 1-7, 12-17, and 23-26. Affirmation of this election must be made by applicant in

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replying to this Office action. Claims 8-11 and 18-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by McGlashen (US 4,714,099). McGlashen discloses a method of manufacturing tires, wherein the tire sidewalls are provided with a directional marking or indicia that is consistent with the direction of the cords in the bead reinforcing plies (Column 2, Lines 45-60). The reference further teaches a method of mounting such tires on a racing car, such that it is desired to mount the tires on the vehicle so that the direction marks on the tires on one side of the vehicle point in the opposite direction to the direction marks on the tires on the other side of the vehicle (Column 3, Lines 15+). In such an instance, any pair of tires having opposite directional markings constitutes the tire kit of the claimed invention.

Regarding claims 3 and 5, the directional marking depicted in Figure 1 can be viewed as a company logo, ornamental design, or decorative pattern.

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7. Claims 12-17 and 23-26 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith (GB 2,381,367). Smith discloses a pneumatic tire construction having colored markings that may be used for advertising and/or to provide an indication of speed that can be seen by spectators (motor racing) (Page 3, Lines 25-30 and Page 4, Lines 20-25).

With respect to claims 13-15 and 24-26, the claims are directed to a tire construction having colored markings. In each instance, the claims contain language that defines the intended use of the color markings, for example to designate the points leader or the rubber compound. It is clearly evident that the tire of Smith has the capability of displaying such information. It is emphasized that the tire of Smith is configured to display a desired advertisement, which could include any of the claimed features (Page 3, Lines 5-15).

As to claims 16 and 17, Smith teaches that each marking can have any length, width, curvature, and orientation (Page 2, Lines 25+).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGlashen and further in view of Williams (US 2,985,216). As noted above,

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McGlashen is directed to a method of including direction markings in the sidewall regions of tires in order to provide accurate mounting. While McGlashen is silent to the use of color, it is extremely well known to form similar tire sidewall markings with color in order to increase the visibility of said marking, as shown for example by Williams (Column 1, Lines 35-65). It is emphasized that the use of color in tire sidewall markings is extremely well known and conventional in the tire industry. As such, one of ordinary skill in the art at the time of the invention would have found it obvious to form the directional markings of McGlashen with color, there being no conclusive showing of unexpected results to establish a criticality for such a construction. It is further noted that the particular selection of colors would have been well within the purview of one of ordinary skill in the art at the time of the invention.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Justin R. Fischer** whose telephone number is **(571) 272-1215**. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, reading "Justin Fischer".

Justin Fischer

January 19, 2006